

Serial No. 09/855,385
Amdt. dated March 2, 2004
Reply to Office Action of November 3, 2004

Attorney Docket No. PF02177NA

REMARKS/ARGUMENTS

Claims 1 through 12 and 14 through 20 remain in this application.

Claims 1 through 5 and 7 are rejected under 35 U.S.C. §102(c) as being anticipated by U.S. Patent No. 6,301,609 B1 to Aravamudan, et al. ("Aravamudan, et al. patent") in view of U.S. Patent No. 6,760, 580 B2 to Robinson, et al. ("Robinson, et al. patent"). Claim 6 is also rejected under 35 U.S.C. §103(a) as being unpatentable over the Aravamudan, et al. patent in view of the Robinson, et al. patent and U.S. Patent No. 6,333,929 B1 to Drottat, et al. ("Drottat, et al. patent").

Claim 1 provides, *inter alia*, dropping an instant message intended for a mobile subscriber from a buddy if the mobile subscriber does not receive the instant message after the instant message is resent a predetermined number of times. Claim 3 provides similar language. Thus, the instant message is dropped if it is not delivered to the mobile subscriber.

Page 2 of the above Office Action states that the Aravamudan, et al. patent "fails to teach that the method of emerging deleting the instant message intended for the mobile subscriber from the one of the buddies if the mobile subscriber does not receive the instant message after the instant message is resent a predetermined number of times", as required by claims 1 and 3. Likewise, the Drottat, et al. patent describes a receiver that sends a negative acknowledge (NAK) to a transmitter to instruct the transmitter to resend previously-sent packets, and the Drottat, et al. patent does not describe or suggest dropping an instant message, as required by claims 1 and 3.

Serial No. 09/855,385
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The Robinson, et al. patent describes deletion of a message name, not deletion of an instant message that is not delivered. Col. 7, lines 30 through 35, of the Robinson, et al. patent states "The following other functions are available: delete; ad; and check status. With regards to the delete function, the instant message routing server 24 deletes each instant message name included in the message content from the instant message name list stored with the user's profile information in the database 26". Thus, the Robinson, et al. patent discloses deletion of one or more *message names*, assigned to an address or phone number (see col. 4, lines 12 through 14), from an instant message name list stored with the user's profile information. Creation of the message name list is shown in FIG. 10A, and an example is provided in FIG. 10B. FIGs. 3 through 7 explain how the message names can be used to deliver an instant message. Although the Robinson, et al. patent describes deletion of an instant message that is successfully delivered at col. 8, lines 16 and 17, the Robinson, et al. patent does not describe or suggest deletion of an instant message that is not delivered, as required by claims 1 and 3.

In addition, the Robinson, et al. patent describes deletion of one or more message names in response to an explicit request from a user to delete the message name by invoking a corresponding instant message function (see col. 7, line 20). Specifically, the invocation is, as described at col. 5, line 66 and 67, "through a user interface on the mobile device 36 the user selects an instant message function". Also, FIG. 10A shows a delete function as "DELETE A BUDDY FROM THE MOBILE DEVICE GROUP". Thus, the Robinson, et al. patent discloses deletion of message names in response to a user request, which is very different from dropping an instant message intended for a mobile subscriber from a buddy if the mobile subscriber does

Serial No. 09/855,385
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Attorney Docket No. PF02177NA

not receive the instant message after the instant message is resent a predetermined number of times, as required by claims 1 and 3.

Therefore, claims 1 and 3 distinguish patentably from the Aravamudan, et al. patent, the Robinson, et al. patent, the Drott, et al. patent, and the combination of these patents.

Claims 2 and 4 through 7 depend from and include all limitations of independent claims 1 and 3. Therefore, claims 2 and 4 through 7 distinguish patentably from the Aravamudan, et al. patent, the Robinson, et al. patent, the Drott, et al. patent, and any combination of these patents for the reasons stated above for independent claims 1 and 3.

In view of the above, reconsideration and withdrawal of the rejections to claims 1 through 7 are respectfully requested.

Claims 8 through 12 and 14 through 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Aravamudan, et al. patent in view of U.S. Patent No. 6,091,710 to Mawhinney ("Mawhinney patent").

Claim 8 provides, *inter alia*, notifying the mobile subscriber when a buddy sends a second message intended for the mobile subscriber subsequent to sending a first unanswered message in which the second message is different from the first unanswered message, and claim 20 as amended provides similar language. Thus, a buddy sends a subsequent message without regard for whether an answer is received for an earlier message. The Aravamudan, et al. patent and the Mawhinney patent do not describe or suggest a buddy that sends multiple messages

Serial No. 09/855,385
Amdt. dated March 2, 2004
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Attorney Docket No. PF02177NA

without regard for whether an answer is received, as required by amended claims 8 and 20.

Therefore, amended claims 8 and 20 distinguish patentably from the Aravamuda patent, the Mawhinney patent, and the combination of these patents.

Claims 9 through 12 and 14 through 19 depend from and include all limitations of independent claim 8 as amended. Therefore, claims 9 through 12 and 14 through 19 distinguish patentably from the Aravamuda patent, the Mawhinney patent, and the combination of these patents for the reasons stated above for amended claim 8.

The above Office Action does not clearly identify how the cited references describe or suggest the above language of claims 8 through 12 and 14 through 20 or why the Examiner believes that the above language is described or suggested by the cited references. Applicants believe that allowance of claims 8 through 12 and 14 through 20 is believed warranted, so a response to the above arguments is respectfully requested.

In view of the above, reconsideration and withdrawal of the rejections to claims 8 through 20 are respectfully requested.

CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Also, no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Serial No. 09/855,385
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The Commissioner is hereby authorized to deduct any additional fees arising as a result of this response, including any fees for Extensions of Time, or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

It is submitted that the claims clearly define the invention, are supported by the specification and drawings, and are in a condition for allowance. Applicants respectfully request that a timely Notice of Allowance be issued in this case. Should the Examiner have any questions or concerns that may expedite prosecution of the present application, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,
Dorenbosch, Jheroen P., et al.

Please forward all correspondence to:
Motorola, Inc.
Law Department (HDW)
600 North US Highway 45, AS437
Libertyville, IL 60048


Hisashi D. Watanabe
Attorney for Applicant(s)
Registration No. 37,465
Telephone: (847) 523-2322
Facsimile: (847) 523-2350

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Date